

Attorney Docket No.: 6263.200-US

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Anker Steen Jorgensen et al

Serial No.: 09/995,987

Group Art Unit: 1614

Filed: November 16, 2001

Examiner: Zucker, Paul A.

Confirmation No: 3030

For: Glucagon Antagonists/Inverse Agonists

CERTIFICATE OF MAILING UNDER 37 CFR 1.8(a)

Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

Sir:

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1. Response to Restriction Requirement

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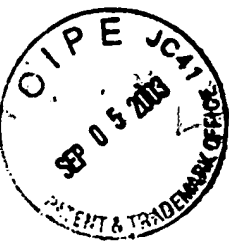
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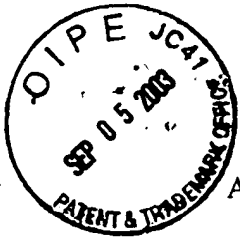
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RESPONSE TO RESTRICTION REQUIREMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In response to the Office Action dated August 18, 2003, which sets forth a restriction requirement, Applicants hereby elect, *with traverse*, the claims of Group I (i.e., claims 1-29, 31, 32, and 62-65) for further prosecution. Applicants respectfully submit that the restriction requirement is improper, in whole or in part, for the reasons set forth herein and, therefore, request withdrawal of the restriction requirement.

Presently, claims 1-29, 31, 32, and 46-65 are pending. Claim 1 is the only pending independent claim.

The Office Action sets forth a three-way restriction requirement between (I) claims 1-29, 31, 32, and 62-65, directed to compositions; (II) claims 46-57 and 59-61, directed to treatment and prevention of glucagon-mediated disorders by use of the claimed compositions; and (III) claim 58 directed to the prevention or treatment of obesity by use of claimed compositions.

With respect to the requirements for imposing a restriction requirement, the MANUAL OF PATENT EXAMINING PROCEDURE (MPEP) states:

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There are two criteria for a proper requirement for restriction between patentably distinct inventions:

(A) The inventions must be independent (see MPEP § 802.01, § 806.04, § 808.01) or distinct as claimed (see MPEP § 806.05 - § 806.05(i)); and

(B) There must be a serious burden on the examiner if restriction is required (see MPEP § 803.02, § 806.04(a) - § 806.04(i), § 808.01(a), and § 808.02).

(MPEP § 803 (emphasis added)). These two separate criteria must both be satisfied to support a proper restriction requirement. The fact that both criteria must be satisfied is made even clearer by the following statement in the MPEP:

If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions.

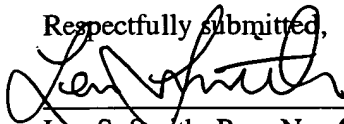
(MPEP § 803 (emphasis added)). Thus, if the subject matter of the pending claims is such that there would be no serious burden on the examiner to search and examine all of the pending claims at the same time, the Examiner is to do so, *even if* the pending claims are drawn to independent or distinct inventions.

With respect to the subject patent application and the outstanding restriction requirement, Applicants note that all of the presently pending claims are dependent on independent claim 1. Therefore, a search directed to the subject matter of Group II or Group III will necessarily entail a search for the compositions of Group I. Indeed, if a search for Group I fails to identify any prior art relevant to the compositions of Group I, all of the presently pending claims should be deemed free of the prior art. Therefore, Applicants respectfully submit that a search of all of the pending claims will not result in a serious burden to the Examiner. Moreover, although the claimed uses of such compounds in Groups II and III may be distinct, a search for art relevant to either use will only entail examining a subset of any art relevant to the subject matter of Group I. As such, Applicants respectfully submit there will be no serious burden on the Examiner to search and examine at least the combination of Groups I and II or Groups I and III at the same time.

Accordingly, Applicants respectfully request withdrawal of the restriction requirement, in whole or in part, such that at least (a) Groups I and II or (b) Groups I and III are considered together. If, in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned attorney.

Date: September 3, 2003

Respectfully submitted,



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